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10/663,372	09/15/2003	Joerg Beringer	09282.0008-00	1628

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EXAMINER

MCCORMICK, GABRIELLE A

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3629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/663,372	Applicant(s) BERINGER ET AL.	
	Examiner GABRIELLE MCCORMICK	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/8/08 and 3/20/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on March 20, 2008.
2. Claims 1, 25 and 26 have been amended.
3. Claims 1-26 are currently pending and have been examined.

Information Disclosure Statement

4. The Information Disclosure Statements filed March 20, 2008 and April 8, 2008 have been considered. Initialed copies of the Form 1449 are enclosed herewith. The Examiner notes that Applicant has submitted 46 patents documents for review. Due to the large number of documents, the Examiner has made a *cursory review* of this collection and requests that the Applicant cite passages relevant to the examination of the filed claims.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed toward an "machine-readable storage medium including machine-readable instructions" (preambles). The specification, in paragraph 0055 on page 18 discusses that the instructions can be received as a "machine-readable signal". A "signal" does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (i.e., process, machine, manufacture, or composition of matter). A suggestion to overcome this rejection is to amend these claims to specifically exclude the receipt of instructions as a "machine-readable signal".

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-4, 8-9, 12-15, 19-22 and 25-26** are rejected under 35 U.S.C. 102(e) as being anticipated by Howard et al. (US Patent No. 6,697,865 hereafter referred to as "Howard").
9. **Claims 1, 8 and 25:** Howard discloses providing portals that simultaneously "present a single coordinated image to selling partners and customers while providing custom experiences for individual users." (C2; L9-11). Howard discloses "relationship portal software" and "business database" (C2; L35-47: *machine readable instructions*). Howard also discloses an example of context information where a sales person manages the permissions for users, one of which is a lawyer. The sales person can set the lawyer's permissions, but would not have access to the legal content. (C8; L9-13). Thus, the lawyer has access to legal content (and therefore the context information appropriate to a lawyer's permissions). Additionally, Howard discloses:
- *generating a user profile corresponding to a user;* (C4; L35-42)
 - *identifying one or more entities related to the user, said one or more entities having corresponding entity profiles including context information;* (C4; L27-35)
 - *associating at least a portion of the context information from the one or more entity profiles to the user profile by importing at least the portion of the context information into the user profile;* (C2; L42-48: relationships between parties are regulated to the extent that the relationship involves the portal-providing company's (i.e., an example of a parent company) information: thus, parent company information (i.e., context information) is provided (i.e.,

- imported) to a child company thru the relationship. C2; L8-11: the interaction of the portal providing company and other companies results in presenting a “single coordinated image” while providing custom experiences for individual users, Thus describing the functionality such that context information is imported into a user profile such that the user views the “single coordinated image” while also having a custom experience (i.e., one that results from the user’s preferences from the user’s profile). C5; L38-50: “Once the permission has been given to a group it is automatically conferred on all members of that group...Any user who becomes a member of a group immediately acquires all the permissions that have been given to the group. The use of groups simplifies administration of permission by enabling a large number of permissions to easily be assigned by putting users in just a few groups.” The permissions constitute an example of context information and the cited immediately acquiring group permissions by users discloses the importing of the context information into the profile of the user. C7; L67-C8; L4: a selling partner of the portal-providing company can create personalized branded web sites for its customers and can reuse (i.e., import) information available on the portal-providing company’s portal.)
- *personalizing a work environment associated with user based on the context information associated with the user profile.* (C2; L56-67: a personal relationship portal that has custom appearances and behaviors for each of the employees).
10. **Claims 14, 19 and 26:** Howard discloses providing portals that simultaneously “present a single coordinated image to selling partners and customers while providing custom experiences for individual users.” (C2; L9-11). Howard discloses “relationship portal software” and “business database” (C2; L35-47: *machine readable instructions*). The relationship between the company (parent) and the user (*child*) is disclosed by Howard in column 4; lines 27-29: “a profile for a company to which a user belongs must exist before a profile for the user can be created.” Howard also discloses an example of context information where a sales person manages the permissions for users, one of which is a lawyer. The sales person can set the lawyer’s permissions, but would not have access to the legal content. (C8; L9-13). Thus, the lawyer has

access to legal content (and therefore the context information appropriate to a lawyer's permissions). Additionally, Howard discloses:

- *generating a child entity profile corresponding to a child entity; (C4; L35-42)*
- *identifying a parent entity profile from which the child entity profile depends, the parent entity profile including context information; (C4; L27-35)*
- *importing at least a portion of the context information from the parent entity profile into the child entity profile, said imported context information comprising inherited context information; (C2; L42-48: relationships between parties are regulated to the extent that the relationship involves the portal-providing company's (i.e., an example of a parent company) information: thus, parent company information (i.e., context information) is provided (i.e., imported) to a child company thru the relationship. C2; L8-11: the interaction of the portal providing company and other companies results in presenting a "single coordinated image" while providing custom experiences for individual users, Thus describing the functionality such that context information is imported into a user profile such that the user views the "single coordinated image" while also having a custom experience (i.e., one that results from the user's preferences from the user's profile). C5; L38-50: "Once the permission has been given to a group it is automatically conferred on all members of that group...Any user who becomes a member of a group immediately acquires all the permissions that have been given to the group. The use of groups simplifies administration of permission by enabling a large number of permissions to easily be assigned by putting users in just a few groups." The permissions constitute an example of context information and the cited immediately acquiring group permissions by users discloses the importing of the context information into the profile of the user. C7; L67-C8; L4: a selling partner of the portal-providing company can create personalized branded web sites for its customers and can reuse (i.e., import) information available on the portal-providing company's portal.)*
- *updating the inherited context information in the child entity profile in response to a change in the corresponding at least a portion of the context information in the parent entity profile. (C4;*

- L49-51: when company permissions are removed, all employee permissions are removed. A specific example of a context based permission that is updated is disclosed in C13; L21-34).
11. **Claims 2 and 20:** Howard discloses explicitly associating context information relating to the user/child entity with the user/child entity profile. (C11; L9-11: the user profile includes preferences and C11; L37-41: the user purposely modifies the user preferences).
12. **Claims 3 and 21:** Howard discloses a configuration function that identifies and creates profiles for companies and employees. The configuration information is kept in a "portal management database 23". (C3; L11-19). Data is gathered from the database by a Java class library. (C3; L48-58). A *context cluster* is understood to be a compilation of data, such as found in database tables, therefore the functionality of the Java class library in gathering data is equivalent to creating a *context cluster*.
13. **Claim 4:** Howard discloses *transporting one or more context clusters into the user profile*. (C4; L45-51: the permissions of a user are limited to the permissions assigned to a company).
14. **Claims 9 and 22:** Howard discloses changing a company profile or modifying a user profile. (C6; L44-47 and C8; L20-37: a change in the company permissions leads to changing (i.e., updating) user permissions).
15. **Claims 12 and 13:** Howard discloses collaborative and business relationships. (C13; L21-34).
16. **Claim 15:** Howard discloses *personalizing a work environment associated with user based on the context information associated with the user profile*. (C2; L56-67: a personal relationship portal that has custom appearances and behaviors for each of the employees).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **Claims 5-7, 10-11, 16-18 and 23-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (US Patent No. 6,697,865 hereafter referred to as "Howard") in view of Hosea et al. (US Pub. No. 2002/0138331 hereafter referred to as "Hosea").
19. **Claims 5, 6, 7, 16, 17 and 18:** Howard discloses the limitations of claims 1 and 14. Howard does not disclose *links to services and information places*.
20. Hosea, however, discloses a system for personalizing Web pages to meet the interests of Web users based on user profiles. (Abstract). Hosea discloses links to "Yahoo! Shopping" (i.e., a service) and "News & Media" (information places) in Figure 11.
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included links to services and information, as disclosed by Hosea in the system disclosed by Howard, for the motivation of providing a method of allowing the user to "more quickly and easily locate material that is most likely to be of interest" (Hosea; P[0050]).
22. **Claims 10, 11, 23 and 24:** Howard discloses the limitations of claims 9 and 22. Howard does not disclose determining relevance of context information and removing based on the relevance.
23. Hosea, however, discloses determining the relevance of content to the user based on an affinity rating (P[0047]). The affinity rating is generated by analyzing the user's Web surfing and click-stream data (P[0042]). Content deemed not to be of interest to the user is eliminated (P[0050]).
24. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included eliminating content based on relevance to the user, as disclosed by Hosea, in the system of Howard for the motivation of reducing "what may be perceived by a user as clutter" and simplifying the presentation of the information such that the user can "more quickly and easily locate material that is most likely to be of interest" (Hosea; P[0050]).

Response to Arguments

25. Applicant's arguments filed March 20, 2008 have been fully considered but they are not persuasive. The Examiner has provided a detailed analysis of "importing at least the portion of the context information into the user profile", above. Particularly, as defined by Applicant's disclosure, context information is equivalent to profile information (P[0019]) and profile information comprises permission' (P[0023] and Fig. 3). Howard discloses the use of user and company profiles and permission setting such that a user is automatically assigned group permissions, thus providing the teaching for importing context information into a user profile.
26. With regard to claims 5-7, 10-11, 16-18 and 23-24, it is unclear what Applicant's argument is when stating that the Office Action has not identified any predictability or reasonable expectation of success of the modification of the reference Howard with Hosea. The Applicant has merely made a general statement without providing any rationale for why the Applicant thinks that the combination of the references would not produce predictable results or have a reasonable expectation of success. In consideration of the motivation to combine the references, as cited above and in the first Office Action, the Examiner considered the expectation of success, as both references address personalizing web pages based on profiles of users, and thus disagrees with Applicant's statement that the Office Action failed to clearly articulate a reason why Howard and Hosea would render the claimed combination obvious to one of ordinary skill in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

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is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629